

**Remarks**

Applicants acknowledge the Final Office Action dated November 14, 2003 and respectfully request reconsideration of the application in view of the above amendments and remarks set forth below. Claim 1 has been amended and no other claims have been added or cancelled. Therefore, claims 1, 3-14 are pending in the present application.

Claims 1 and 3-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of U.S. Patent No. 5,878,496 to Liu et al. ("the Liu reference"). Applicants respectfully traverse this rejection.

Amended claim 1 is directed to a process for forming a metal cylindrical bearing roller consisting of the steps of: 1) obtaining a hardened metal cylindrical blank having end face surfaces, a lateral surface defining an outer diameter, and a centered circular bore, the bore having an inner surface defining an inner diameter; 2) honing the inner surface of the bore having a specified inner diameter, thereby forming an inner bearing surface; and 3) hard turning the lateral surface of the blank to a specified outer diameter, thereby forming an outer bearing surface concentric with the inner bearing surface, wherein the hard turning the lateral surface of the blank further includes forming a radial crown,

and wherein said end face surfaces are unmachined thereby forming a metal cylindrical bearing roller.

In addition to the arguments presented in previous responses, it is further submitted that none of the references of record, taken alone or in combination, teach or suggest a process consisting of forming a metal cylindrical bearing roller wherein the end face surfaces are unmachined as recited in amended claim 1.

See *Specification*, pg. 7, lines 5-6; pg. 10, lines 3-4. In contrast, the end surfaces of the bearing race (10) in the Liu reference are machined. In particular, as best seen in FIG. 3 of the Liu reference, reference numeral 10 is directed to the end surface of the bearing race. Therefore, the discussion in the Liu reference related to machining the bearing race also includes machining the end surfaces of the bearing race. See Col. 5, lines 28-29, 44-63; Col. 9, lines 14-20.

Moreover, amended claim 1 includes the transitional phrase "consisting of," which excludes any additional element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520 (C.C.P.A. 1931). The additional step in the Liu reference of machining the end surfaces is clearly not included in the process of the present invention. See *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572 (Fed. Cir. 1984) (stating that the Applicants' patent application may not be used as a basis for the motivation to combine or modify the prior art to

arrive at the claimed invention). Therefore, the Liu reference does not teach or suggest the process of claim 1.

By providing a process consisting of forming a metal cylindrical bearing roller wherein the end face surfaces are unmachined, numerous advantages are realized. For instance, eliminating the step of finishing the end surfaces reduces the number of finishing steps and machining operations, while being less capital intensive. See *Specification*, pg. 5, line 22; pg. 6, lines 1-9; pg. 10, lines 3-10.

Since the references of record do not teach or suggest a process where the end face surfaces are unmachined, Applicants request that the rejection of claim 1 be withdrawn. As claims 3-14 depend either directly or indirectly from claim 1, Applicants request that the rejection of these claims be withdrawn for at least the same reasons set forth above with respect to amended claim 1.

### **Conclusion**

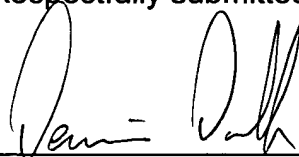
In view of the foregoing amendment and remarks, Applicants submit that claims 1 and 3-14 are patentable over the references of record and are in condition for allowance. Should the Examiner feel that there is any unresolved issues that remain in this case, the undersigned may be contacted at the telephone number listed below to arrange for an issue resolving conference.

Applicants hereby authorize the Commissioner to charge the fee of \$770.00 required under 37 C.F.R. § 1.17(e) for the Request for Continued

Examination, the fee of \$420.00 required under 37 C.F.R. § 1.17(a)(2) for the two-month extension of time, and any other fee that may have been overlooked to Deposit Account No. 10-0223.

Respectfully submitted,

4/5/04  
Date

  
Dennis B. Danella  
Reg. No. 46,653

**JAECKLE FLEISCHMANN & MUGEL, LLP**  
39 State Street  
Suite 200  
Rochester, New York 14614-1310  
Telephone: (585) 262-3640  
Facsimile: (585) 262-4133